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1 RECORD OF ORAL HEARING  
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3

4  
5 BEFORE THE BOARD OF PATENT APPEALS  
6 AND INTERFERENCES  
7

8 *Ex parte* THOMAS M. COLLINS, KEVIN L. RABINOVITCH,  
9 NEIL A. WILLCOCKS, MARK J. CHIMEL, HENRY V. IZZO and  
10 ROBERT W. TUTTRUP  
11

12 Appeal 2010-000728  
13 Application 09/855,584  
14 Technology Center 2400  
15

16 Oral Hearing Held: June 8, 2010  
17  
18

19 Before JAY P. LUCAS, STEPHEN C. SIU, and DEBRA K. STEPHENS  
20 *Administrative Patent Judges*  
21  
22

23 ON BEHALF OF THE APPELLANT:  
24

25 SAMUEL BORODOCH, ESQ.  
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1 THE USHER: Calendar No. 11, Appeal No. 2010-000728, Mr.  
2 Borodoch.

3 JUDGE LUCAS: Thank you, Pat. Samuel Borodoch?

4 MR. BORODOCH: Yes.

5 JUDGE LUCAS: Can you give Mr. Carr your card, if you have  
6 one. Samuel Borodoch. B-o-r-o-d-o-c-h.

7 MR. BORODOCH: I apologize. I actually don't seem to have  
8 one on me. My apologies.

9 JUDGE LUCAS: I just spelled it out. Welcome,  
10 Mr. Borodoch. We have conveniently not given you a clock on the wall. It's  
11 totally at our discretion when the 20 minutes ends.

12 MR. BORODOCH: Understood.

13 JUDGE LUCAS: I'll try to give you a warning and tell you it's  
14 time to sum up at the end. You may be interrupted by questions at any time.

15 MR. BORODOCH: Thank you very much.

16 JUDGE LUCAS: Please start.

17 MR. BORODOCH: If it pleases this Honorable Board, the  
18 invention claimed in the present application relates to the transmission of  
19 electronic mail and particularly to the handling of attachments to e-mail  
20 messages.

21 As the use of e-mail messages with attachments has  
22 proliferated, the load on the networks or other systems carrying the  
23 messages increases significantly. Reducing unnecessary network capacity is  
24 therefore highly desirable.

25 Claim 23 is an exemplary independent claim that recites a  
26 method for transmitting electronic mail from a sender to multiple recipients.  
27 The method includes designating at least one recipient to receive a message  
28 and an attachment, designating at least one recipient to receive the message  
29 without the attachment.

30 The method also includes enabling a recipient to create and edit  
31 a reception profile which indicates the recipient's preferences with regard to  
32 receipt of prospective attachments.

1           Of particular importance is the claim feature about the reception  
2 profile which is created and edited by a recipient and impacts the  
3 transmission process at the sender or transmission side.

4           In particular, as we recited, for example, in Claim 23, the  
5 message is transmitted from the sender without the attachment to any  
6 recipient whose reception profile specifies not to receive an attachment.  
7 Thus, regardless of whether or not the sender designated the recipient to  
8 receive the attachment, the message is transmitted from the sender without  
9 the attachment if the recipient reception profile indicates that the recipient  
10 does not wish to receive such an attachment.

11           Benefits of the claimed invention include, for example,  
12 reducing the load of a network environment and avoiding unnecessary use of  
13 network capacity.

14           The Examiner finally rejected Claim 23 and other claims as  
15 obvious from a combination of three references, Foladare, Redpath and  
16 Beck.

17           The rejection should be reversed because none of the references  
18 discloses or renders obvious a method in which the recipient side impacts  
19 transmission processes at the sender or transmission side. Instead, the cited  
20 references disclose attachment related processes that take place either  
21 exclusively on the recipient side or exclusively on the sender side.

22           Specifically, Foladare allows only for the recipient side to  
23 control the recipient side decisions, and Redpath and Beck allow only for the  
24 sender or transmission side to control the sender side decisions.

25           Therefore, even if the disclosures in the references were  
26 somehow combined, a person of ordinary skill would have had no reason to  
27 modify the references so as to obtain the claimed subject matter.

28           Allow me to address the references in greater detail. Foladare  
29 discloses an e-mail distribution system that allows a user having incoming  
30 e-mail to be distributed to multiple receiving devices such as personal  
31 computers, PDAs or pages. When the incoming e-mail is sent from a sender  
32 to a user with attachments, the e-mail distribution system distributes the

1 e-mail out to the receiving devices with all, some or no attachments,  
2 depending on, for example, the type of receiving device.

3 In particular, Foladare discloses a centralized electronic mail  
4 device that receives an e-mail message from a sender's device and distributes  
5 that e-mail to a variety of other devices according to information stored in a  
6 profile database.

7 In other words, distribution of the e-mail in accordance with  
8 information in the centralized e-mail device occurs only after the e-mail has  
9 been transmitted from the sender's device to the centralized e-mail device  
10 with the attachment.

11 Therefore, Foladare allows for the recipient side of the system  
12 to impact the distribution of messages on the reception side. The  
13 information stored in the profile database in Foladare does not impact  
14 whether or not attachments are transmitted from the sender's device.  
15 Instead, the decision to send the e-mail message with or without the  
16 attachment and in particular, to load an e-mail onto the network with or  
17 without the attachment, is made exclusively at the sender or transmission  
18 side, and is unaffected by information at the recipient side, including the  
19 centralized electronic mail device.

20 Foladare's centralized electronic mail device does not and  
21 cannot impact whether or not the e-mail is transmitted from the sender's side  
22 with or without an attachment. Indeed, Foladare does not even recognize the  
23 possibility of controlling sender side decisions from the recipient side.

24 Let me turn to the second reference cited by the Examiner.  
25 Redpath discloses an e-mail notification process with a new addressee line  
26 identifier that allows an e-mail sender to notify additional addressees of what  
27 has been sent to the primary addressee without slowing down transmission  
28 time or wasting storage space by including unneeded and possibly large  
29 attachment files.

30 On the sender or transmission side, Redpath's new addressee  
31 line identifier allows an e-mail sender to send an icon to indicate an  
32 attachment has been sent to another user. However, the sender alone and not

1 the addressee, not the recipient, controls which addressee line identifier is  
2 used.

3 Thus, the transmission process is controlled in Redpath entirely  
4 at the sender or transmission side. Therefore, whether or not a recipient  
5 receives an attachment is controlled by the sender exclusively.

6 There is nothing in Redpath to suggest that any action that the  
7 recipient side impacts whether a message is transmitted from the sender with  
8 or without an attachment.

9 Let me turn now to the third reference cited by the Examiner,  
10 Beck.

11 Beck discloses a method for transmitting e-mail attachments by  
12 replacing the attachment at the sender's side with an attachment reference.  
13 Thus, instead of transmitting the attachment, a reference or pointer is  
14 transmitted with the message, whereas the attachment itself is stored locally.

15 At the recipient side, a user can later access the attachment by  
16 clicking on the attachment reference.

17 As relevant here, Beck is similar to Redpath. Whereas, Redpath  
18 discloses sending an attachment icon in place of the attachment, Beck  
19 discloses sending an attachment reference or a pointer in place of the  
20 attachment.

21 In Redpath and Beck, replacement of the attachment with an  
22 icon or attachment reference is based solely on the decision at the sender or  
23 transmission side. Whether or not the attachment to the e-mail is sent is not  
24 based on the reception profile created by a recipient as cited in the  
25 independent claims.

26 Thus, Beck like Redpath, does not disclose that transmission of  
27 an attachment from the sender to a recipient is impacted by a reception  
28 profile created by a recipient.

29 Even if there was some reason to combine Foladare, Redpath  
30 and Beck, at most, that might suggest replacing an e-mail attachment either  
31 with an attachment icon as in Redpath or with an attachment reference as in

1 Beck. In any event, the replacement of an attachment still would be  
2 independent of information from the recipient side.

3 The Examiner's Answer alleges incorrectly that the claimed  
4 language does not require that the recipient's reception profile impact the  
5 transmission process at the sender or transmission side. This is contrary to  
6 the plain language of the claims which recite that a message is transmitted  
7 from the sender without the attachment to any recipient whose reception  
8 profile specifies not to receive an attachment. This is regardless of whether  
9 the sender designated the recipient to receive the attachment or not.

10 In summary, the rejection of the claims based on the  
11 combination of Foladare, Redpath and Beck should be reversed.

12 JUDGE LUCAS: I'm sorry, I thought you were summarizing.

13 MR. BORODOCH: Summarizing the first point. I'd like to  
14 address some of the dependent claims.

15 JUDGE LUCAS: Let's pause for a second. I forgot to  
16 introduce Judge Stephens from North Carolina who is joining us.

17 JUDGE STEPHENS: Hello.

18 MR. BORODOCH: Good morning.

19 JUDGE LUCAS: Do either of you have any questions at this  
20 point?

21 JUDGE SIU: No questions.

22 JUDGE STEPHENS: I do. I would like to know where you  
23 have support for the sender being just the device and not including the entire  
24 network up until the recipient. Is there support in your spec for that?

25 MR. BORODOCH: I think that would be the sender and the  
26 specification discloses various hardware and software based components of  
27 the system, which make it readily clear that in the context of this application,  
28 the claim language when it uses "sender" is clearly referring to -- it could be  
29 the initial sender device that an individual is using, but to interpret "sender"  
30 in the context of the pending claims, as including the entirety of a system,  
31 other than the recipient, would not make any sense, particularly when one  
32 contrasts that with the prior art, particularly, for example, Foladare, which is

1 the primary reference cited, the centralized electronic mail device, number  
2 160 in Figure 1 of Foladare, is connected to the sending party user's device,  
3 number 100, only by way of the network.

4 It's clear to interpret the centralized electronic e-mail device in  
5 Foladare, for example, as being somehow part of the sending device or the  
6 device 100 that the sending party uses. It is contrary to the specification in  
7 its entirety in the pending application and it is clearly inconsistent with  
8 Foladare, which makes it clear the centralized electronic mail device is on a  
9 different part of the network or the system, it can only be accessed by a user  
10 device or the recipient devices by going through the network itself.

11 Therefore, even if in some circumstances, in the present  
12 application, the sender could be interpreted to include something other than  
13 the sender's device, it certainly could not be extended to include the  
14 centralized electronic mail device of Foladare.

15 JUDGE LUCAS: Can the sender be a device?

16 MR. BORODOCH: I think in the context of the application,  
17 that would not be inconsistent. Some of the claims I've been focusing on --

18 JUDGE LUCAS: The answer is yes?

19 MR. BORODOCH: Yes. Even if one were to do so, again,  
20 extending the concept of a sender, whether it was a device or not, to  
21 incorporate what is disclosed by Foladare and then to render obvious the  
22 claimed invention would not make sense at all if one focuses on the claim  
23 language.

24 Again, the centralized e-mail device in Foladare simply is not  
25 part of the sender or sender device under any reasonable interpretation of  
26 Foladare. It's on the other side of a network, completely independent of  
27 what the sender does.

28 JUDGE LUCAS: We understand your point. Are there any  
29 other issues that you would care to raise before Mr. Borodoch moves on?

30 (No response.)

31 JUDGE LUCAS: Okay.



1 MR. BORODOCH: The Examiner also rejected some of the  
2 dependent claims as obvious from Foadare, Redpath and Beck, and further  
3 in view of a fourth reference, Ulrich. Ulrich, like the other references, fails  
4 to disclose or render obvious a method in which the recipient side impacts  
5 transmission processes at the sender side.

6 Ulrich discloses e-mail synchronization between a desktop  
7 computer and a mobile device. According to Ulrich, a user of a mobile  
8 device may wish to receive only certain attachments or e-mail messages  
9 chosen by the user dynamically on an ad hoc basis or chosen according to  
10 pre-selected filtering criteria.

11 Ulrich discloses further that the user can decide to download an  
12 attachment during synchronization. Synchronization is a specific process of  
13 coupling the mobile device and a desktop device such that the two devices  
14 can contain the same updated information.

15 The desktop computer and the mobile device interact at the  
16 recipient side and thus, the transmission process at the sender's side is not  
17 influenced. In other words, Ulrich, like the other references, fails to disclose  
18 or render obvious a method in which the recipient side impacts transmission  
19 processes at the sender's side.

20 The dependent claims rejected in view of Ulrich are patentable  
21 for another reason as well. These claims recite the additional features that  
22 the profile created by the recipient can specify that the recipient is not to  
23 receive attachments during a particular time frame. Neither Ulrich or the  
24 other references disclose or render obvious the subject matter of these  
25 dependent claims.

26 With respect, for example, to Claim 43, the Examiner  
27 acknowledged that the combination of Foadare, Redpath and Beck does not  
28 explicitly teach a profile that specifies that a recipient is not to receive  
29 attachments during a particular time. Instead, the Examiner relies on Ulrich,  
30 which discloses that a field on a mobile device can indicate whether an  
31 e-mail includes an attachment and whether the attachment is scheduled to be  
32 downloaded.

1           However, there is no disclosure relating a scheduled  
2       synchronization through a profile that specifies the recipient is not to receive  
3       attachments during a particular time frame.

4           The Examiner's Answer also points to another portion of Ulrich  
5       at Column 12, line 33, which states that the user of a mobile device can  
6       select a parameter in the user profile to automatically send all attachments or  
7       some of the attachments or no attachments.

8           The Examiner's Answer argues that if the none option is  
9       chosen, then no attachments will be downloaded at the next synchronization.  
10      The Examiner argues that this is "functionally equivalent to the recipient not  
11      receiving attachments during a particular time frame."

12          That is incorrect for several reasons. First, according to Ulrich,  
13      even if the user of the mobile device selects to have none of the attachments  
14      sent automatically, the user profile fails to specify a particular time frame  
15      during which attachments will not be sent. Instead, attachments will not be  
16      sent at any time.

17          Furthermore, the Examiner's Answer improperly refers to  
18      functionally equivalent as being the standard under Section 103. Functional  
19      equivalency is not the proper standard for obviousness under that section.

20          In any event, Ulrich does not disclose assigning specific time  
21      frames to any restriction on receiving e-mail attachments.

22          Accordingly, the rejections of the dependent claims based on  
23      Ulrich should be reversed for these additional reasons as well.

24          Thank you.

25          JUDGE LUCAS: Are there any questions on chapter two?

26          (No response.)

27          JUDGE LUCAS: Did you want to summarize?

28          MR. BORODOCH: In summary, for all the reasons identified  
29      in the Appeal Brief and Reply Brief and today at the hearing, we would urge  
30      the Board to reverse all the rejections and allow all the claims, and thank you  
31      very much for your time.

1 JUDGE LUCAS: Thank you very much for coming in, Mr.  
2 Borodoch.

3 JUDGE STEPHENS: Thank you.

4 JUDGE SIU: Thank you.

5 MR. BORODOCH: Thank you.

6 Whereupon, at 10:58 a.m., the proceedings were concluded.  
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